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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
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EXAMINER

QUAN, ELIZABETH S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1743

7

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,542

Applicant(s)

FATTINGER ET AL.

Examiner

Elizabeth Quan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Referring to claim 1, the repeated language, such as "a sample tube is insertable within the inner wall of the storage compartment and into the storage compartment from either the top side of the frame or the bottom side of the frame and is removable from the storage compartment from either the top side of the frame or the bottom side of the frame" render the claim indefinite. Additionally, "with one and the same orientation of the sample tube with respect to the frame" renders the claim indefinite. What orientation of the sample tube is being referred to? What is meant by "one and the same orientation"?

4. Referring to claim 2, the existing language of the claim render the indefinite. Technically, each of the compartments are dimensioned to hold an entire sample tube.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S.

Patent No. 5,080,232 to Leoncavallo.

Referring to claims 1 and 4, Leoncavallo discloses a rack (10, 20) for use in a compound handling system for handling a multiplicity of tubes containing aliquots of chemical or biological samples. The rack comprises a single piece frame (22) with a top side and bottom side and storage compartments (24) configured and dimensioned to receive a sample tube containing chemical or biological sample (see FIGS. 2, 3, and 6; COL. 2, lines 40-66). The storage compartments (24), each of which has an inner wall, are open at the top and bottom side of the frame (22) so that a sample tube can be inserted within the inner wall of the storage compartment and into the storage compartment (24) from either the top or bottom side of the frame (22) with one and the same orientation of the sample tube with respect to the frame (22) (see FIGS. 2, 3, and 6; COL. 2, lines 40-66). The retaining means (34) for retaining a sample tube within each of the storage compartments (24) is an integral part of the frame (22) as part of the inner wall of each storage compartment (24) (see FIGS. 2, 3, and 6; COL. 3, lines 32-59). The retaining means (34) is configured and dimensioned to cooperate with a part of the outer wall of a sample tube in order to retain the sample tube at a predetermined position within the compartment (24) (see FIGS. 2, 3, and 6; COL. 3, lines 32-59). The retaining means (34) for retaining a sample tube (36) comprises a projection of the inner wall of each storage compartment (24) that is configured and dimensioned to bias against a sample tube (36)

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positioned within the storage compartment (24) (see FIGS. 2, 3, and 6; COL. 3, lines 32-59). Therefore, Leoncavallo includes all the limitations in claims 1 and 4.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,579,929 to Schwartz.

Referring to claims 1 and 4, Schwartz discloses a rack (1) for use in a compound handling system for handling a multiplicity of tubes containing aliquots of chemical or biological samples. The rack comprises a single piece frame (11) with a top side and bottom side and storage compartments (14) configured and dimensioned to receive a sample tube containing chemical or biological sample (see FIGS. 1 and 1a; COL. 6, lines 46-55). The storage compartments (14), each of which has an inner wall, are open at the top and bottom side of the frame (11) so that a sample tube can be inserted within the inner wall of the storage compartment and into the storage compartment (14) from either the top or bottom side of the frame (11) with one and the same orientation of the sample tube with respect to the frame (11) (see FIGS. 1 and 1a; COL. 6, lines 46-55). The retaining means (24, 25) for retaining a sample tube within each of the storage compartments (14) is an integral part of the frame (11) as part of the inner wall of each storage compartment (14) (see FIGS. 1, 1a, and 2; COL. 6, lines 46-55; COL. 7, lines 4-67; COL. 8, lines 1-65). The retaining means (24, 25) is configured and dimensioned to cooperate with a part of the outer wall of a sample tube in order to retain the sample tube at a predetermined position within the compartment (14) (see FIGS. 1, 1a, and 2; COL. 6, lines 46-55; COL. 7, lines 4-67; COL. 8, lines 1-65). The retaining means (24, 25) for retaining a sample tube (10) comprises a projection of the inner wall of each storage

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compartment (14) that is configured and dimensioned to bias against a sample tube (10) positioned within the storage compartment (14) (see FIGS. 1, 1a, and 2; COL. 6, lines 46-55; COL. 7, lines 4-67; COL. 8, lines 1-65). Therefore, Schwartz includes all the limitations in claims 1 and 4.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,080,232 to Leoncavallo as applied to claim 1 above, and further in view of U.S. Patent No. 5,048,957 to Berthold et al.

Referring to claim 2, while Leoncavallo does not disclose compartments configured and dimensioned to receive an entire sample tube, Berthold et al. show cuvettes (20) entirely enclosed within the cuboid blocks (10) of the specimen rack (see FIG. 2; COL. 4, lines 21-25). Berthold et al. do not explicitly state why the cuvettes (20) are completely enclosed within the cuboid blocks (10) of the specimen rack; however, it appears the enclosure protects light-sensitive samples. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rack of Leoncavallo by extending the inner walls of the storage compartments to completely enclose the sample tubes within the compartments as in Berthold to protect light-sensitive samples.

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6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,579,929 to Schwartz as applied to claim 1 above, and further in view of U.S. Patent No. 5,048,957 to Berthold et al.

Referring to claim 2, while Schwartz does not disclose compartments configured and dimensioned to receive an entire sample tube, Berthold et al. show cuvettes (20) entirely enclosed within the cuboid blocks (10) of the specimen rack (see FIG. 2; COL. 4, lines 21-25). Berthold et al. do not explicitly state why the cuvettes (20) are completely enclosed within the cuboid blocks (10) of the specimen rack; however, it appears the enclosure protects light-sensitive samples. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rack of Schwartz by extending the inner walls of the storage compartments to completely enclose the sample tubes within the compartments as in Berthold to protect light-sensitive samples.

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,080,232 to Leoncavallo as applied to claim 1 above, and further in view of U.S. Patent No. 5,514,343 to Verwohlt et al.

Referring to claim 3, Leoncavallo acknowledges that the storage compartments (24) may have any desired shape (see COL. 2, lines 67 and 68; COL. 3, line 1). While Leoncavallo do not explicitly disclose rectangular storage compartments, it is well known in the art to employ rectangular storage compartments as evidenced by Verwohlt et al. Verwohlt et al. disclose that the apertures (13) may have a polygonal shape, such as a rectangle or square (see COL. 2, lines 13-14). Therefore, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to modify the rack of Leoncavallo to use the convention rectangular storage compartments as in Verwohlt as desired.

Referring to claim 5, Leoncavallo discloses a projection (34) capable of snapping in between two ridges of the outer wall of a sample tube. Leoncavallo do not disclose a sample tube with two ridges on its outer wall. Verwohlt et al. disclose tubes (16) with two ridges forming a groove (22) with which a projection can snap into firm engagement (see FIGS. 3 and 4; COL. 5, lines 6-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rack of Leoncavallo to include a tube with two ridges forming a groove for engagement with a projection as in Verwohlt et al. for firmly grasping and fixing the position of the tube.

8. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,579,929 to Schwartz as applied to claim 1 above, and further in view of U.S. Patent No. 5,514,343 to Verwohlt et al.

Referring to claim 3, Schwartz does not explicitly disclose rectangular storage compartments, it is well known in the art to employ rectangular storage compartments as evidenced by Verwohlt et al. Verwohlt et al. disclose that the apertures (13) may have a polygonal shape, such as a rectangle or square (see COL. 2, lines 13-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rack of Schwartz to use the convention rectangular storage compartments as in Verwohlt as desired.

Referring to claim 5, Schwartz discloses a projection (24, 25) capable of snapping in between two ridges of the outer wall of a sample tube. Schwartz do not disclose a sample tube with two ridges on its outer wall. Verwohlt et al. disclose tubes (16) with two ridges forming a groove (22) with which a projection can snap into firm engagement (see FIGS. 3 and 4; COL. 5, lines 6-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rack of Schwartz to include a tube with two ridges forming a groove for engagement with a projection as in Verwohlt et al. for firmly grasping and fixing the position of the tube.

Response to Arguments

9. The submission of new informal drawings for Fig. 1 indicating line A-A has been accepted.
10. Applicant's arguments filed 5/9/2002 have been fully considered but they are not persuasive. While neither Verwohlt et al. nor Berthold et al. disclose storage compartments each of which is open at both ends, Rothermal et al. discloses a test tube support that has opening at both ends. Rothermal et al. modifies the teachings of the primary reference Verwohlt et al. to provide the missing limitation. Certainly, Rothermal et al. do not provide the retaining means, which are an integral part of the rack frame. However, Verwohlt et al. provides the retaining means. Berthold et al. modifies the teachings of Verwohlt et al. to contain an entire sample tube within the storage compartment. Verwohlt et al. in view of Rothermal et al. addresses all the limitations in claims 1 and 3-5. Verwohlt et al. in view of Rothermal et al., and further in view of Berthold et al. addresses the limitation in claim 2. However, new rejections have been applied due to an updated search revealing relevant prior art.

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11. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art contains at least one limitation of the claims.

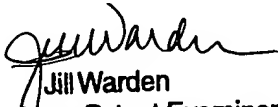
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 879-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan
Examiner
Art Unit 1743

eq
July 14, 2002


Jill Warden
Supervisory Patent Examiner
Technology Center 1700